In the Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1364

RHONE-POULENC, S.A., ET AL., PETITIONERS

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

Petitioners are a French corporation and several scientists who seek to patent a new process for preparing a known antibiotic drug, daunorubicin. They seek certiorari from a decision of the Court of Appeals for the Fourth Circuit which, while agreeing with petitioners that the Commissioner of Patents acted arbitrarily and capriciously in requiring cancellation of a portion of their written description of their new process, remanded to the Commissioner of Patents with leave to allow an amendment to the description in a manner consistent with petitioners' proof. The decision of the court of appeals is correct, and further review by this Court is not warranted.

Petitioners specified in their patent application that microorganisms other than those which they identified fail to give "any production of antibiotic and anti-

tumour substance identical to daunorubicin" (Pet. App. 11a). The examiner and the Commissioner agreed that petitioners' process was patentable but required deletion of the phrase "and anti-tumour" from the specification portion of the application. The district court granted summary judgment for the Commissioner (Pet. App. 13a-16a). The court of appeals reversed, holding that "cancellation of the words 'anti-tumour' by the Patent Office was arbitrary and capricious" and stating that (Pet. App. 12a):

> [t]he cancellation requirement is set aside with leave to the Commissioner to allow an amendment restricting the specification to assertions that are supported by the applicants' proof. [Footnote omitted.]*

Petitioners argue that the court of appeals lacked jurisdiction to remand with instructions to allow them to amend their application to make it consistent with the proof offered in support thereof. But in a case within its jurisdiction, as this one is, a court of appeals clearly has the power to remand with instructions. *E.g., Ford Motor Co.* v. *National Labor Relations Board*, 305 U.S. 364, 373-374; *Federal Trade Commission* v. *Curtis Publishing Co.*, 260 U.S. 568, 580; *Braniff Airways, Inc.* v. *Civil Aeronautics Board*, 379 F.2d 453, 468 (C.A. D.C.). Further, the

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*The Commissioner of Patents has proposed to permit petitioners to amend their application to state that microorganisms other than those used by petitioners fail to give "any production of an antibiotic and anti-tumour substances effective in treating certain tumors, namely lymphosarcoma, nephroblastoma, neuroblastoma, acute lymphoblastic leukemia, and acute myeloblastic leukemia, identical to daunorubicin * * *" (Pet. App. 37a).

court of appeals did not decide an issue outside of the record, as petitioners claim, since the issue of what type of language was permissible in the application was contested throughout the proceedings below.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

JUNE 1975.